

United States
COURT OF APPEALS
for the Ninth Circuit

THE UNITED STATES NATIONAL BANK
OF PORTLAND, OREGON, TRUSTEE, and
WALTER G. E. SMITH, *Appellants,*

vs.

FABRI-VALVE COMPANY OF AMERICA, a
corporation, *Appellee.*

FABRI-VALVE COMPANY OF AMERICA, a
corporation, *Appellant,*

vs.

THE UNITED STATES NATIONAL BANK
OF PORTLAND, OREGON, TRUSTEE, and
WALTER G. E. SMITH, *Appellees.*

PLAINTIFFS-APPELLANTS' REPLY BRIEF

*Appeals from the United States District Court for the
District of Oregon.*

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The File Wrapper and Contents

Plaintiffs-Appellants respectfully direct the Court's attention to the fact that only in the first three Office actions handed down by the Commissioner of Patents

were citations made of prior art patents against the claims pending in the Smith application, and in the third action only one claim was rejected as being met by the prior art. From the very beginning applicant's attorney and the Examiner at the Patent Office endeavored to come to an agreement regarding the accuracy and definiteness of the claims—the Examiner repeatedly pointing to the inaccuracy or indefiniteness, and the attorney attempting to cure these defects by presenting new claims. The Examiner found novelty and invention in the valve from the very first, as evidenced by the history of the prosecution of the application as contained in the file wrapper.

Claims 3, 4 and 5, presented with the application as filed, were declared to be allowable on the first Office action. In the amendment responsive to the first Office action, claim 3 was cancelled, apparently inadvertently, and for some reason the attorney attempted to amend claim 5 and succeeded only in rendering this claim inaccurate, for which reason it was rejected in the following Office action.

In the second Office action, the Examiner's rejection of claim 3, supported by the statement that both Atcheson and Glass provided a recess on what may be considered the inlet side of the valve, was obviously in error, and the claim should have been reinstated in the application. The previously allowed claim 5 was rendered inaccurate by the amendments entered therein, and was rejected because of the inaccuracy. Claim 12, presented in the amendment in response to the first Office action, was allowed, and claims 13, 14, 15 and 16

were rejected, *not as unpatentable over any prior art*, but as indefinite in failing properly to define the invention.

In the third Office action, the Examiner directs attention to the fact that claims 1 to 3 and 5 to 11 have been cancelled; that claim 4 appears to be allowable; and that claims 12 to 18 and 20 are rejected as indefinite. The applicant, by means of his "whereby" clause, is saying that *a recess removes the material lodged in the recess*. Only claim 19 is rejected on the prior art. However, instead of correcting the indefiniteness of the claims by appropriate amendments, the attorney for applicant cancelled all of the claims, including the allowed claims, and substituted therefor the claims now appearing in the patent as issued.

It is important to note that the majority of Smith's claims were not rejected on the prior art. The primary reason for the rejection of the claims in the Smith application was that the claims as drawn were indefinite and inaccurate.

Original claims 1 through 11 were presented with the application as filed, and constitute a part of the disclosure of the original application. Smith illustrated and described the recess *j* in the floor of the housing and the cut away portion *m* of the groove *g* on the inlet side. Claims 6, 7 and 8 confirm that it is the recess *j* in the floor of the housing—being extended laterally to communicate with the groove *g*—which cuts away the wall of the groove on the inlet side. The following are portions of claims 6, 7 and 8 which relate to the structure in question:

Claim 6: "a recess in the floor of said housing on the inlet side of said gate, said recess extending laterally whereby *the walls of said guide grooves* of the gate *are cut away by the recess* on the inlet side," (Italics supplied)

Claim 7: "a recess in the floor of said housing on the inlet side of said gate, said recess gradually increasing in depth to said gate and extending laterally whereby *the walls of said guide grooves* of the gate *are cut away by the recess* on the inlet side." (Italics supplied)

Claim 8: Same as claim 7.

In his response to the first Office action, Smith entered additional claims 12-16, inclusive, claims 13 and 15 containing language describing the manner in which the lower walls of the gate grooves on the inlet side were cut away by the recess in the floor of the housing. These claims were declared to be allowable in substance. The language of the claims is as follows:

Claim 13: "a recess provided in the floor of said housing on the inlet side of said gate, said recess extending laterally, and *cutting away the lower walls of said gate grooves* on the inlet side," (Italics supplied)

Claim 15: "a recess provided in the floor of said housing in the inlet side of said gate, said recess extended laterally, and *cutting away the lower walls of said gate grooves* on the inlet side," (Italics supplied)

Claim 1 of the patent calls for grooves formed in the side walls of said housing, the side walls of the inlet side being provided at the bottom with cavities connecting with said grooves, in which to receive the material scraped off by the gate while being closed. There is no

doubt that "the side walls of the inlet side" refers to the side walls of the grooves, because all during the prosecution of the application Smith repeatedly says the "*walls of said guide grooves of the gate are cut away*", and there is no indication that he changed the meaning of this term when he used it in claims 1 and 2 of the patent to describe the same structure.

In the Office action following the presentation of claims 12 to 16, claim 12 was declared to be allowable; claim 13 was rejected as indefinite, but the Examiner told Mr. Smith how to amend the claim to cure the indefiniteness, and stated that the claim would be considered allowable if the claim were so amended. Smith amended the claim as directed by the Examiner, but the claim was again rejected as indefinite because of the wording of the "whereby" clause. The Examiner did not reject the claim as unpatentable over any prior art. Claims 14, 15 and 16 were rejected as indefinite, but the Examiner told Mr. Smith how to amend these claims to cure the indefiniteness, and said that if so amended these claims would be considered allowable. Thus, it is established on the record that *the invention defined by these claims was patentable over any of the prior art.*

Scope of the patented claims.

The "cavities" in the side walls of the groove *g* on the inlet side, as defined by claims 1 and 2 of the patent, are one and the same thing as the recess *j* in the floor of the housing, being extended laterally to cut away the walls of the grooves on the inlet side and thus establish

communication with said grooves, as described in the specification and in the claims presented during prosecution of the application. This being true, then claims 1 and 2 of the patent are of broader scope than claims 12 and 13, presented in the amendment filed May 19, 1931.

In making a comparison of claims 1 and 2 of the patent with claims 1 and 2 of the application as originally filed, and claims 12 and 13, presented with the amendment filed May 19, 1931, it will be helpful to consider the *function of the apparatus defined by each claim*. It will be noted that there is some difference in the structure defined by the several claims—that is, some of the claims call for certain elements which are omitted by other claims. The reason for the omission of some elements from certain claims is that the omitted elements are not necessary to perform the functions pointed to by the several claims. For example:

The function of the structure defined by claims 1 and 2 of the patent is to clear the guide grooves of accumulated pulp. The elements necessary to perform this function are recited by these claims as a gate slidable between inlet and outlet ports in grooves formed in the side walls of the housing, the side walls of the inlet side [of the grooves] being provided at the bottom with cavities connecting the said grooves to facilitate removal of material from the grooves by the gates while being closed. Claim 2 differs from claim 1 only in that it provides that the floor of the inlet side of the housing inclines downwardly toward the cutting edge of the gate when in closed position.

The function of the structure defined by *original claims 1 and 2* is to scrape away the material adhering to the valve housing adjacent the outlet port—and there is no doubt that Smith had in mind the face *c'* of the housing part *c*. Note that the groove is not mentioned in either of these claims, and that, additionally, each claim recites that the gate is beveled on the inlet side at its lower edge in order the better to scrape the surface *c'*. The intended function of the structure defined by claims 1 and 2 of the application as filed is described on page 1, column 2, lines 41-49, where it is said:

“By this construction, any pulp stock or other material which may collect on the face *c'* of the housing part *c* is scraped off by the gate *h* into the recess *j*, hence is prevented from being compressed or otherwise adhering to the valve housing, or interfering with the operation of the valve. When the gate is again opened, the material so collected in the recess will be carried away by the flow of material through the gate valve.”

The function of claims *1 and 2 of the patent* is told on page 2, column 1, lines 16-23. This structure *includes the groove g*, the fact that the wall of the groove on the inlet side is cut away as at *m* down to the inclined bottom surface *j* so that stock that has accumulated *in the groove* is scraped off by the edge of the gate and discharged into the bottom surface or floor of the housing, to be carried away with the next flow of material through the valve. In these claims, therefore, the groove is a necessary element, as is likewise the recitation of the fact that the wall of the groove on the inlet side is cut away—“provided with cavities”—at the bottom in order that the groove may be relieved of the material

scraped off by the gate while being closed. The claim says to "receive" the material scraped off by the gate, but it is clear that the intended function is as described in lines 19 et seq. on page 2, column 1 of the patent:

"thus any stock that has accumulated in said grooves is scraped off by the edge of the gate and discharged onto the bottom surface or floor of the housing and carried away with the next flow of material through the gate valve."

Claim 12 calls for a gate slidable in grooves formed in the side walls of the housing, *the gate being beveled on the inlet side* at its lower end to form a knife edge. The remaining element of the claim is defined as a recess provided in the floor of the housing in the inlet side of the gate, whereby material dislodged into said recess by the operation of the gate will be scoured away by the flow of material therethrough. While this structure could be interpreted broadly enough to point to the function of clearing accumulated stock from both the groove and the face *c'* of the housing part *c*, there is no doubt that claim 13 does contemplate both of these functions, and so it is believed that claim 12 points only to the function of clearing the face *c'* of the housing part *c*.

Claim 13 includes as an element, "a recess provided in the floor of said housing in the inlet side of said gate, said recess being extended laterally and the lower walls of said gate groove being cut away." Because the claim recites that the lower end of the gate is beveled to form a knife edge, and also that the recess is extended laterally to cut away the wall of the groove on the inlet side

“whereby material dislodged into said recess by the operation of the gate will be scoured away by the flow of material therethrough”, it is believed that claim 13 points to the *dual function of clearing both the groove and the face c' of the housing part c.*

With these considerations in mind, it will readily be seen that claims 1 and 2 of the patent are not readily comparable with those claims of the application which were intended to point to a different function; and there is no doubt, also, that these claims are of broader scope than the claims presented during prosecution of the application which were intended to perform the *same* function. It should be remembered that claim 12 was declared to be allowable, and claim 13 to be allowable in substance, in the Office action of October 29, 1931.

At no time during the prosecution of the application for the patent in suit was any requirement made by the Examiner that Smith limit his structure to one having an outlet port of any particular shape. It is interesting to note that not only did Smith refrain from putting any such limitation in more than one-half of the claims pending during prosecution of the application, but the limitation as to shape of the outlet port does not appear in the first two claims of the patent in suit. The V-shaped opening in plaintiffs' valve is the preferred form of opening in a valve embodying the principles of the Smith construction, but a round or oval opening is clearly an equivalent thereof, and to so hold does not enlarge plaintiffs' claims. At no time did the Examiner indicate allowance or rejection of a claim merely be-

cause of Smith's inclusion therein of the limitation that the outlet port is or is not V-shaped.

The shape of the opening through the transverse wall is immaterial. In claim 3, therefore, the recitation that the lower end of the opening through the transverse wall is V-shaped is surplusage. This particular limitation could have been omitted from the claim without in any wise affecting patentability of the claim or its validity. Mr. Smith's testimony regarding this feature is as follows:

"Q. Your first valves were with a round opening?

A. Correct, and as I said to you a moment ago, the first valve after 20 years is still functioning.

Q. Now is it true that whether it be a round opening or a V-shaped opening that the valves function the same?

A. They appear to; they appear to." (Trans. p. 78)

The Smith invention embodies a transverse wall-gate-groove structure. Smith's gate is made to *slide against the transverse wall* by grooves formed in the side walls of the housing.

"By this construction, any pulp stock or other material which may collect on the face *c'* of the housing part *c* is scraped off by the gate into the recess *j* hence is prevented from being compressed or otherwise adhering to the valve housing, or interfering with the operation of the valve." (Col. 2, lines 41-46, Smith patent)

Strange as it may seem, *the prior art does not show an instance where the gate is made to slide against the face of the valve seat to effect a scraping action to keep the valve seat clean*. See, for example, Glass, whose gate is

loosely mounted and is pressed against its seat *after* it is moved into the annular groove in the valve housing. Other patents of record in this case showing gates which are moved *obliquely into seating position* and which do not scrape the face of the seat are Belfield 105,027; Allt 233,180; Lunken 494,579; Lunkenheimer 494,581 and 494,582; Patterson 985,444; Snow 1,179,047; and Barker 1,751,122. It is well known, of course, that a wedge-shape gate, such as shown by Gill or Hewes, does not contact its seat during opening and closing movements. Atcheson's sled runners E tend to move the gate F' obliquely into seating engagement with the seat H'.

Another advantage produced by the invention developed by Smith is found in the fact that a transverse wall or a valve seat for the gate supports the gate against the thrust of the pressure of the inlet fluid while the gate is being closed.

The prior art definitely proves that it was unknown prior to the Smith patent to provide *gate* valves for installation in such a manner that fluid pressure would tend to *force the gate toward the seat*. On cross-examination, defendant's counsel tried to get Mr. Smith to say that "There are many types of valves in which there is no wall at or on the inlet side of the gate", but Mr. Smith reminded defendant's counsel that such valves were not *gate* valves, and defendant's counsel then admitted that he was speaking of valves generally. Mr. Smith reminded him that such valves were flap valves, disc valves, check valves, and many others wherein the construction is quite different from that of a gate valve.

A further novel feature found in the combination of elements defined by Smith's claims is attested to by the fact that before the introduction of the Smith valve, valves used in pulp mills were characterized by structures in which the grooves for the gates extended around the circle of the valve housing or across the floor of the valve. Illustrative patents are Glass 109,001; Hewes 127,768; Allt 233,180; Lunken 494,579; Lunkenheimer 494,581 and 494,582; Snow 1,179,047; and Barker 1,751,122. Of this type of structure the Smith patent says (col. 1, lines 24-32):

"Further, in a gate valve of this class, the pulp stock or other material tends to collect in the guideways or grooves of the gate and cause the latter to bind and makes it very difficult to operate. This is aggravated by the fact that pulp, if permitted to dry, forms a hard glue-like substance from which the gate may only be broken away by taking the valve housing apart."

Smith purposely avoided a structure wherein a groove extends around the complete circle of the valve housing, so that there would be no groove in the floor of the valve wherein material would tend to collect. Smith was not trying to avoid a cylindrical outlet opening, but rather to avoid a continuous groove around the full circle of the outlet opening, and the language of the Smith patent appearing in column 1, lines 16-24, must be so interpreted. The shape of the opening is immaterial. Smith believes, however, that a V-shaped opening is more efficient than a cylindrical opening.

To provide a scouring action to remove the pulp in front of the transverse wall when the gate is opened,

Smith caused the lower portion of the wall on the inlet side of the groove to be cut away and so form a recess in the floor of the housing on the inlet side of the gate. When the gate is opened the material which has collected in the recess is carried away by the flow of material through the valve by reason of the turbulence created by the transverse wall.

Defendant's valves are provided with a transverse wall extending around the full circle of the valve housing, which transverse wall forms the outlet side of the groove in which the gate slides and which supports the gate against the thrust of the pressure of the inlet fluid while the gate is being closed. The wall of the groove on the inlet side is cut away across the floor of the valve housing so that any pulp stock which accumulates in the groove and which is shoved out of the groove by the descending gate and onto the floor of the housing will be carried away by the flow of material through the valve when the gate is opened. The elements of defendant's valve are identical with the elements of plaintiffs' valve—the principle difference being that defendant employs a welded construction while plaintiffs' valves are cast.

Defendant has appropriated all of the features of the Smith construction, and now seeks to avoid the liability for infringement by saying that the Smith patent is a very narrow one covering a very minor improvement in a highly developed art, and that the claims of the Smith patent are of such limited scope that they do not embrace the valves as manufactured by the defendant.

The Smith valve was readily accepted by a great and important industry, which still proclaims the Smith valve as the best of this type of equipment yet offered for its use. The claims are to be construed in the light of the real invention, and, while they cannot be given a construction broader than the actual teachings of the patent as shown by the drawings and specifications, there is no doubt but that the Smith patent taught Fabri-Valve Company of America how to construct the infringing device. As stated in 69 C.J.S., Sec. 204, page 677:

“Claims, and the terms used therein, must be so construed, where possible, as to sustain, rather than invalidate, the patent and protect the real invention, and must be so construed where possible, under the circumstances, to preserve the substance of the patent, and should be liberally construed so as to uphold, and not destroy, the rights of the inventor in the substance of his invention. Courts should be careful to avoid such construction of the claims as will defeat the real discovery which the inventor is contributing to the art.”

Respectfully submitted,

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